



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,028	04/08/2004	Norman E. Williams	P06279US01 - PHI 1337	9239
27142	7590	04/10/2008		
MCKEE, VOORHEES & SEASE, P.L.C.				
ATTN: PIONEER HI-BRED				
801 GRAND AVENUE, SUITE 3200				
DES MOINES, IA 50309-2721				
EXAMINER				
KUBELIK, ANNE R				
ART UNIT		PAPER NUMBER		
1638				
MAIL DATE		DELIVERY MODE		
04/10/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/821,028

Applicant(s)

WILLIAMS ET AL.

Examiner

Anne R. Kubelik

Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-15, 17, 18, 23-27 and 30-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-6, 11, 17, 18 and 34 is/are allowed.
- 6) ☒ Claim(s) 7-10, 12-15, 25-27, 30-33 and 35 is/are rejected.
- 7) ☒ Claim(s) 23 and 24 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-849)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 24 January 2008 has been entered.
2. Claims 1-15, 17-18, 23-27 and 30-35 are pending.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. The objection to claims 19-22 under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim is obviated by Applicant's cancellation of the claims.
5. The rejection of claims 28-29 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention is obviated by Applicant's cancellation of the claims.
6. The previously indicated allowability of claims 7-10, 12-15, 23-27 and 30 is withdrawn in light of the new rejections and objections below.

Claim Objections

7. Claims 23-24 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the

claim(s) in independent form. The claimed plants do not have all the characteristics of the plant of parent claim 11; thus, the claims do not properly depend from the parent claim.

Claim Rejections - 35 USC § 112

8. Claims 7-8, 12-15, 25-27, 30-33 and 35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Neither the instant specification nor the originally filed claims appear to provide support for claims to an F1 hybrid maize seed comprising an inbred maize plant cell of inbred maize line PH6ME (claim 7). The specification only discusses F1 hybrid maize seed in general, with no limitations to maize seed produced when PH6ME is the female parent, which is the only way the claimed seeds are possible. Claim 8 similarly has new matter.

Neither the instant specification nor the originally filed claims appear to provide support for claims to a plant with all of the morphological and physiological characteristics of PH6ME and further comprising a single locus or transgene (claims 23-24). Similarly, neither the instant specification nor the originally filed claims appear to provide support for claims to methods of breeding using plants with all of the morphological and physiological characteristics of PH6ME (claims 12-15, 25-27). There is no indication in the specification that the transformation and crossing methods were contemplated as being applied to plants with all of the morphological and

physiological characteristics of PH6ME. For example, introgression of a new locus is only discussed as applying to PH6ME (pg 21, lines 2-29).

Neither the instant specification nor the originally filed claims appear to provide support for claims to the method of claim 25. A text search of the specification for “0-5” found no matches.

Neither the instant specification nor the originally filed claims appear to provide support for claims to the method of claim 30. A text search of the specification for “profile” found no matches.

Neither the instant specification nor the originally filed claims appear to provide support for claims to the method of claim 31. A text search of the specification for “three” and “3” found matches in the context generations in producing a converted plant.

Neither the instant specification nor the originally filed claims appear to provide support for the conversion traits being improved nutritional quality, herbicide tolerance, resistance to bacterial, fungal, nematode or viral disease, male sterility or restoration of male fertility. The discussion of single gene conversion on pg 21 only provides support for nutritional enhancements, herbicide resistance and disease resistance, with no reference to male sterility or fertility at all.

Thus, such claims constitute NEW MATTER. In response to this rejection, Applicant is required to point to support for the claims or to cancel the new matter.

Neither the instant specification nor the originally filed claims appear to provide support for a plant of inbred maize variety PH6ME being able to be produced by transformation of PH6ME, as in claim 35. Maize variety PH6ME has a fixed genetic gene set; transformation of a

transgene into the plant would alter the genetic make-up of maize variety PH6ME, thus making the plant some other variety.

Claim Rejections - 35 USC § 102 / 35 USC § 103

9. Claim 32 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hoffbeck (1998, US Patent 5,723,723).

Hoffbeck teaches inbred maize line PH44A. The prior art plants differ from the claimed plants only by their method of manufacture, given that the plant of 32 can have an unlimited number of new traits. However, the claimed method of making the converted plant of claim 32 would not distinguish them over the inbred maize plants taught by the prior art. See *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985), which teaches that a product-by-process claim may be properly rejectable over prior art teaching the same product produced by a different process, if the process of making the product fails to distinguish the two products.

Double Patenting

10. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Art Unit: 1638

11. Claims 9-10 rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-2 of prior U.S. Patent No. 6,759,578. This is a double patenting rejection.

12. Claims 1-6, 11, 17-18 and 34 are allowed.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne R. Kubelik, whose telephone number is (571) 272-0801. The examiner can normally be reached Monday through Friday, 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg, can be reached at (571) 272-0975.

The central fax number for official correspondence is (571) 273-8300.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

Anne Kubelik, Ph.D.

April 10, 2008

/Anne R. Kubelik/

Primary Examiner, Art Unit 1638